

REMARKS

Claims 1-24, 27 and 28 are pending. By this Amendment, claims 1-9, 12, 16 and 19-24 have been amended and claims 28 and 29 added. No new matter is involved.

Support for the language " wherein at least some of the support members of the second frame absorb energy associated with a shock wave that strikes the window pane" recited in claims 28 and 29 is found throughout the original disclosure including, for example, page 3, lines 4-12, and original claim 8.

Initially, Applicants acknowledge with appreciation the courtesies extended by Examiner Trans A to Mr. Webster, their undersigned representative, during the personal interview conducted on December 18, 2003.

The following remarks include Applicants' summary of that interview.

Applicants acknowledge with appreciation the indication of allowable subject matter in claim 9. Applicants have not re-written claim 9 in independent form, however, because they believe that claim 1, which serves as the base claim from which claim 9 depends and, therefore claim 9, are allowable for reasons stated below.

The Office Action rejects claims 1, 3 and 5 under 35 U.S.C. 112, second paragraph because terms in those claims lack proper antecedent basis. This rejection is respectfully traversed.

Claim 1 has been amended to recite "a first frame" in line 2; and claim 3 has been amended to recite, in lines 1 and 2, that "at least some of the support members have first and second arm portions." These amendments provide proper antecedent basis for (1) the terms "said first frame" in lines 2-3 of claim 1; (2) the terms "the arm portions" in line 5 of claim 3; and (3) the terms "the second arms" in claim 5. Claim 1 has also been amended to change "fixable" in line 2 to --adapted to be fitted--, in accordance with the suggestion of Examiner Trans A during the interview. These Amendments do not narrow the scope of the claims.

Rather, they merely clarify the meaning of the claims. Similarly, the amendments made to all of the claims do not narrow the scope of the claims.

Claims 6 and 7 are rejected under 35 U.S.C. §112, second paragraph as being indefinite. This rejection is respectfully traversed. Claim 6 has been amended to recite that the second frame is displaceable by forces associated with a shock wave striking the window pane, thereby overcoming any indefiniteness associated with the previous recitation of "generation of forces." Support for this language appears throughout Applicants' disclosure including, for example, on page 3, in lines 17-20.

Claim 12 is rejected for not having proper antecedent basis for "the adhesive material." This rejection is respectfully traversed. Claim 12 has been amended to depend from claim 11, which recites "an adhesive material."

Claims 16 and 21 are rejected because "it is unclear what method/process applicant is intending to encompass." This rejection is respectfully traversed.

Claim 16 has been amended to indicate that the window system is "adapted to be fitted in the opening behind an existing window system installed in the wall opening." The meaning of claim 16 is clear and does not involve any method steps. Claim 21 has been amended to recite that the framework "is adapted to be fitted behind an existing window system installed in the opening." The meaning of claim 21 is clear and does not involve any method steps. Applicants respectfully directs the Examiner's attention to the discussion of "adapted" language, below, in connection with the rejection of claims 1-24 under 35 U.S.C. §112, second paragraph.

Claim 16 is rejected under 35 U.S.C. §101 for reciting a use without setting forth any steps in the process. This rejection is respectfully traversed.

Claim 16 does not recite a use of anything. Therefore, this rejection is without merit.

Claim 19 has been amended for consistent use of the terms "first frame" and "second frame."

Claims 21 and 22 are rejected under 35 U.S.C. §112, second paragraph because claim 21 depends from itself. This rejection is respectfully traversed.

Claim 21 has been amended to depend from claim 20, thereby obviating the basis for this rejection.

Claims 1-24 are rejected under 35 U.S.C. §112, second paragraph as being indefinite. This rejection is strenuously traversed.

The basis for this rejection is that the relationship of "the structural limitations of first frame, fixing members, arm portions, securing means, leg portions, flange, protrusion, fixation screw, adhesive, and gaskets of window system or framework" must be claimed in combination to clearly set forth the combination. As an example, the Office Action alleges that "for engagement with the arm portions" is indefinite; and that "fixation screw adapted for bearing against a . . . arm" is indefinite.

Applicants respectfully submit that claims 1-24, 26 and 27 satisfy all the requirements of 35 USC §112, second paragraph.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. §112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976). In that case the court did not require Venezia's claims to recite its elements as being interconnected. In this Application, claim 1, for example, uses the transitional wording, "comprising" and only needs to recite those elements which distinguish the invention from the prior art. The definiteness of claim language is analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing ordinary skill in the pertinent art, In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Furthermore, the appellant may use functional language, alternative expressions, negative limitations, or any style of

expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. See in this regard, In re Swinehart, 439 F.2d 210, 160 226 (CCPA 1971).

Applicants also reproduce, below, pertinent portions of the holding in the Venezia decision, cited above:

"We have reviewed the disputed claims and in particular the language criticized by the examiner and the board. We conclude that the claims do define the metes and bounds of the claimed invention with a reasonable degree of precision and particularly, and that they are, therefore, definite as required by the second paragraph of section 112. In re Conley, 490 F.2d 972, 180 USPQ 454 (CCPA 1974); In re Miller, 58 CCPA 1182, 441 F.2d 689, 169 USPQ 597 (1971); In re Borkowski, 57 CCPA 946, 422 F.2d 904, 164 USPQ 642 (1970). As we view these claims, they precisely define a group or "kit" of interrelated parts. These interrelated parts may or may not be later assembled to form a completed connector. But what may or may not happen in the future is not a part of the claimed invention. The claimed invention does include present structural limitations on each part, which structural limitations are defined by how the parts are to be interconnected in the final assembly, if assembled. However, this is not to say that there is anything futuristic or conditional in the "kit" of parts itself. For example, paragraph two of claim 31 calls for "a pair of sleeves * * * each sleeve of said pair adapted to be fitted over the insulating jacket of one of said cables." (emphasis added). Rather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is so structured or dimensioned that it can be fitted over the insulating jacket of a cable. A similar situation exists with respect to the "adapted to be affixed" and "adapted to be positioned" limitations in the third and fourth paragraphs of the claim. The last paragraph of claim 31 contains additional language criticized by the board, including "may be slideably positioned,"

"slideably repositioned," "when said sleeves * * * are assembled," and "when said housing is in its repositioned location." However, this language also defines present structures or attributes of the part of the "kit" identified as the housing, which limits the structure of the housing to those configurations which allow for the completed connector assembly desired. Again, a present structural configuration for the housing is defined in accordance with how the housing interrelates with the other structures in the completed assembly. We see nothing wrong in defining the structures of the components of the completed connector assembly in terms of the interrelationship of the components, or the attributes they must possess, in the completed assembly. More particularly, we find nothing indefinite in these claims. One skilled in the art would have no difficulty determining whether or not a particular collection of components infringed the collection of interrelated components defined by these claims. In re Miller, supra. (emphasis added)

Applicants respectfully submit that the recitation in the claims of the various recited elements is clear, and one of ordinary skill in the art can readily determine the metes and bounds of the invention without any further recitations. The two phrases which the Office Action finds objectionable are the same type of phrases that the Court of Customs and Patent Appeals (now, the Court of Appeals for the Federal Circuit) expressly found to be acceptable. There is nothing improper about the "adapted to" language.

Like the invention in the "Venezia" case, cited above, rather than being a mere direction of activities to take place in the future, Applicants' claim language imparts structural limitations to the recited system components. With respect to claim 4, for example, some of the flange portions are so structured or dimensioned that they can be engaged with the first arm portions of the support members. With respect to claim 16, for example, the window system of claim 1 is so structured or dimensioned to fit behind an existing window system installed in a window opening.

The test for compliance with the second paragraph of 35 U.S.C. 112, as stated in Miles Lab., Inc. v. Shandon Inc., 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993), cert. denied, 510 U.S. 1100 (1994) is whether one skilled in the art would understand the bounds of the claims when read in light of the specification. If the claims, read in light of the specification, reasonably apprise those skilled in the art of the scope of the invention, Section 112 demands no more. See, also, In re Merat, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975), which stated that the question under Section 112, second paragraph is whether the claim language, when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bonds of the claimed subject matter are distinct. See, also, In re Warmerdam, 33 F3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

The second paragraph of 35 U.S.C. 112 requires claims to be set out and circumscribe a particular area with a reasonable degree of precision and particularity, In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977).

All of Applicants' claims satisfy these requirements.

In this regard, Examiner Trans A appears to agree with this position based on his suggestion to change "fixable" to --adapted to be fitted-- in line 2 of claim 1. It is noted that Applicants have also made such a change in claim 20, and include the "adapted to be fitted" language in new claims 28 and 29.

The Office Action rejects claims 1, 2, 10, 14, 18, 19 and 22 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,879,957 to Habicht et al. ("Habicht"). This rejection is respectfully traversed.

Habicht discloses an impact-impeding pane/frame structure, which comprises a casement frame 2 and an outer window opening frame 3. The frame 2 carries a pane 1 and is provided with profile section 5 which comprises distributed on its inside perimeter elements

7, 9, 12, 13, 14, 15, 17 and 18. The frame 3 is provided with profiled section 4 which comprises distributed on its inside perimeter elements 6, 8, 10, 11, 16 and 18. Frame 2 and frame 3 are provided with corresponding metallic impact-impeding section 20 and 19, respectively, which are divided therebetween by a labyrinthine gap 21. The purpose of this gap is to deflect a projectile entering the gap from its original trajectory. By virtue of this provision, the kinetic energy of the profile would be depleted.

The profiled sections 4 and 5 contact each other in two points, through resilient elements, which are not designated by reference numerals. The resilient elements are inserted in respective grooves made in section 4 and section 5. As frame 2 carries the pane, it corresponds to the second frame of the present invention, while the frame 3 corresponds to the first frame of the present invention. All elements depicted on page 5 of the Office Action (that is an enlarged portion of Fig. 1 of Habicht) refer solely to the first frame and they do not show that the first frame supports the second frame. Applicants respectfully submit that the characterization of the labeled elements seen on page 5 of the Office Action as fixing members of the first frame, support elements of the second frame, arm portion and leg portion of the support members, is incorrect.

Applicants respectfully submit that, contrary to the assertion in the Office Action, the first frame of Habicht, that is, frame 2, is not provided with a plurality of fixing members. The elements 7, 9, 12, 13, 14, 15, 17 and 18 are grooves, bulges, insulation rods and metallic webs. These elements are not fixing members; they are not designed for, and not capable of, supporting the second frame within the first frame.

Applicants respectfully submit that they have failed to find in Habicht any securing means which could secure a position of the second frame within the first frame.

During the interview, when discussing the rejection, including the labeled image of a portion of Fig. 1 of Habicht on page 5 of the Office Action, Applicants noted that while the

Office Action's page 5 discussion labels just one element as "support members" (plural), only one element in Fig. 1 is identified as a support member. Claim 1 recites "a plurality of support members", and Fig. 1 does not disclose "a plurality of support members."

Additionally, Applicants pointed out that claim 1 recites that the second frame carries a reinforced window pane secured within the second frame, whereas the only portion of the window of Habicht's Fig. 1 that is identified as the second frame merely does not even touch the window pane. Instead, what is identified in the Office Action as Habicht's second frame is not labeled and appears to be separated from the pane by an unlabeled element. Moreover, what the Office Action identifies as the second frame appears to only be on one side of the pane. Accordingly, the pane cannot be said to "secured within the second frame," as claimed in both independent claims (1 and 20) and, therefore, in all claims.

Moreover, the Office Action does not identify what, in Habicht, constitutes "a securing means for securing position of the second frame within the first frame" that is provided for "at least some of said fixing members." Applicant cannot find such a securing means in Habicht, nor was what constitutes such a securing means explained during the interview.

Additionally, the unlabeled elements in Habicht's Fig. 1 that the Office Action alleges constitute the first and second frames are not shown in Habicht to be "separate" as recited, and the feature that "the first frame is removably installable therein" [in the second frame], which is a proper structural feature of the claim, is not disclosed in Habicht, nor is it addressed in the rejection.

Accordingly, the frame structure of Habicht does not disclose the features which are positively recited in independent claim 1 and dependant claims 2, 10, 14, 18, 19 and 22 and, thus, those claims are not in any way anticipated by Habicht. Accordingly this rejection of 1, 2, 10, 14, 18, 19 and 22 is improper and should be withdrawn.

The Office Action rejects claims 20-24 under 35 U.S.C. §102(b) as anticipated by Habicht. This rejection is respectfully traversed.

Claims 21-24 depend from claim 20, and are not anticipated by Habicht for reasons similar to the reasons stated above with respect to the traversal of the rejection of claim 1 over the Habicht reference, because claim 20 is an independent claim which includes features similar to those of claim 1.

Accordingly, this rejection of claims 20-24 is improper and should be withdrawn.

The Office Action rejects claims 1, 3-8, 11, 13 and 17 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,248,933 to Katoh. This rejection is respectfully traversed.

Katoh discloses synthetic resin window molding and is intended for use in vehicles. The object of Katoh is to provide a synthetic resin window molding or trim strip, which is free from noise vibration and which is less prone to damage from car body vibrations. The Office Action alleges that elements 5, 11, 1e1, 3a4 and 6, seen in Fig. 42 of Katoh, are respectively a first frame, fixing members, supporting members and securing members. Applicants respectfully disagree with this interpretation and allegation. Element 5 is a car body and is not a frame of a window. Element 1e1 is a central portion of strip 1 and is not a support member. Element 3a4 is a seal lip, which forms a seal with the vehicle body 5. This element is not a support member. Element 6 is a stud, having a T-shape and it is rigidly secured on the car body by welding. Accordingly, element 6 is not a fixing member removably attached to a frame of a window.

The elements labeled by the Examiner on page 8 of the Office Action, which shows an enlarged fragment of Fig. 42, are improperly attributed to a first frame, a second frame, fixing members and flange portions. The labeled elements are respectively, a car body, a trim strip, a stud and a clip. These elements are not disclosed as elements of dismantable protective windows as claimed.

Moreover, the car body, which is what the office characterizes as Katoh's first frame, is not disclosed as part of a reinforced window system for opening within a wall, or as a framework for a removable reinforced window system, nor does Katoh disclose "a plurality of support members distributed on an outside perimeter of the second frame, or a securing means, as recited

Accordingly, Katoh does not anticipate claims 1, 3-8, 11, 13 and 17, the rejection is improper, and the rejection should be withdrawn.

The Office Action rejects claims 1 and 17 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,758,459 to Koike et al. ("Koike"). This rejection is respectfully traversed.

Applicants respectfully submit that Koike does not disclose all the features recited in claims 1 and 17. For example, Koike does not disclose a reinforced window system which has a first frame fixable to an opening, nor does it have a second frame removably installable in the first frame, nor does it have a pane secured with the second frame, nor does it have a securing means for securing position of the second frame within the first frame.

Koike describes a sash frame for attaching glass, in which a shaped seal gasket is used. The object of Koike is preventing the shaped seal gasket from coming off of a frame member and preventing the glass from coming off of a sash frame even if the glass is broken. Koike uses glass 7 which has, on one side thereof, a coating 9 made of polyester film to prevent separating and scattering in pieces even if a certain object is blown off by a strong wind and collides with and cracks or breaks the glass 7. The sash frame of Koike does not have a reinforced window pane, as does the claimed invention. In this regard, Koike is applied an anticipatory reference and must disclose each and every claimed feature either explicitly or inherently (necessarily, not just possibly or probably).

In Koike, element 21 is a bead member which is not fixed to the window opening but rather to a body frame member 20.

In Koike, element 2 is a lower transverse frame member which is not removeably installable in the first frame, that is bead member 21, as alleged - see page 9, lines 1-4 of the office Action, but is secured through a transverse member 8 in the window opening.

In Koike, element 7 is a glass which is not carried by the second frame, as recited in the claimed invention, but is removeably inserted between shaped seal gaskets 70 and seal members 60. Applicants respectfully submit that they do not find in Koike any information indicated that the glass is bound to any of the transverse members 1, 5 or 2 or is secured on them.

Applicants also have been unable to find in Koike any securing means associated with hooks at the bottom of frame 2 which would be capable of securing position of the frame member 2 within the bead member 21.

During the interview, Examiner Trans A stated that first frame 21 has hooks on the lower portion which fit into corresponding elements of element 22. However, element 22 in Koike is not a hook. It is described as a channel - see col. 4, lines 10-16, for example.

Additionally, as pointed out in the interview, bead 21, which the office Action asserts is the "first frame adapted to be fixed to the opening" in a wall, is not affixed to a wall opening or adapted to be fixed to a wall opening. Bead 21 is not disclosed as an attachment member. Element 8 in Koike, which runs parallel to bead 21, and below Bead 21, is described as an attachment member, so it is attached to the edge portion C of the opening, but bead 21 is not disclosed as being, or adapted to be, attached to the wall opening.

Moreover, Koike does not disclose the "securing means" recited in the last clause of both claims 1 and 20, nor is this feature addresses in the rejection.

Accordingly, the Office Action does not make out a prima facie case of anticipation by Koike of the invention recited in claims 1 and 17.

The Office Action rejects claim 15 under 35 U.S.C. §103(a) as unpatentable over Habicht in view of Koike. This rejection is respectfully traversed.

Claim 15 depends from claim 14 which in turn depends on claim 1 and claim 15 is patentable over Habicht taken alone or in combination with Koike at least for the reasons state above with respect to the traversal of the rejection of claim 1.

Moreover, in Habicht, the pane is situated between two sealing gaskets. The gaskets are part of the same frame, that is inner casement frame 2. The Office Action indicates that this frame is the first frame. Although it is not explicitly stated in the description of Habicht, nevertheless, an inspection of the drawings reveals that the gaskets are resilient. In Koike, the glass is surrounded by two elements, one of which is resilient and member 70. This seal member is carrying by the bead member 21 which the Office Action alleges to be the first frame. Because Habicht already uses resilient sealing members situated on opposite sides of the pane, it is not clear why one of ordinary skill in the art would be motivated to fit a resilient member between the pane and the first member by combining the teaching of Habicht with the teaching of Koike.

Accordingly, this rejection of claim 15 is improper and should be withdrawn.

The Office Action rejects claim 16 under 35 U.S.C. §103(a) as unpatentable over Habicht in view of U.S. Patent No. 4,625,659 to Saelzer. This rejection is respectfully traversed.

Initially, applicants note that because claim 16 depends on claim 1 it is patentable with respect to Habicht taken alone or in combination with Saelzer at least for the reasons stated above with respect to the traversal of the rejection of claim 1.

The motivation to combine these two references is allegedly because if they were combined "it would provide double protection to the opening against exterior forces as taught by Saelzer." Applicants respectfully submit that this is not a reason to combine these

references but merely is a statement of what would happen if they were combined and that the proper motivation to combine does not exist in either reference. One reason why these references are not proper to combine is that Saelzer does not disclose a window system adapted to be located, or retrofittable, behind an existing window system installed in a wall opening. In Saelzer, a bullet and an explosion proof security structure which is mounted on an existing window or door is disclosed. In other words, the disclosure shows that the structure of Saelzer is mounted on the existing window or door and not behind it.

Additionally, Saelzer is not properly combinable with Habicht because Saelzer describes a security window or door employing flat security members 11, 33 made of bullet proof material. The security members are configured as plates, which are secured in frames 2, 4 to protect critical areas of the ventilation gap from projectiles. This protection mechanism is essentially and fundamentally different from the impact impeding gap mechanism employed in Habicht, that is in which a projectile is deflected from its trajectory by a labyrinthine gap provided between the frames.

Accordingly, the rejection of claim 16 is improper and should be withdrawn.

The Office Action rejects claim 12 under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 4,248,933 to Katoh in view of U.S. Patent No. 6,455,819 to Pohl et al. ("Pohl"). This rejection is respectfully traversed.

Claim 12 depends from claim 1 and is patentable over Katoh taken alone or in conjunction with Pohl at least for the reasons stated above that claim 1 is not anticipated by Katoh. With respect to Pohl, Applicants respectfully submit that is a cooking apparatus and has nothing to do with the field of brass protective windows and the only reason this far afield reference was chosen appears to be solely on hindsight reconstruction of Applicants' invention based on Applicants' own disclosure.

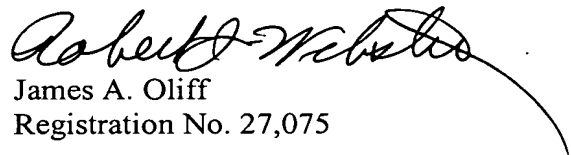
Accordingly, the rejection of claim 12 is improper and should be withdrawn.

Applicants have added claims 28 and 29, each of which recites that at least some of the support members of the second frame are capable of dissipating energy associated with a shock wave striking the window pane. This positively recited feature is not disclosed in any of the applied references. Accordingly, new claims 28 and 29 are patentable over the applied art.

For the aforementioned reasons, Applicants respectfully submit that claims 1-24, 28 and 29 are patentable over the applied art and should be allowed.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,


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Date: December 22, 2003

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